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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

17

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 17

Application Number: 09/740,216
Filing Date: December 18, 2000
Appellant(s): SNOW, ROGER M.

Mark Litman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/6/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

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(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the scope of claims 21, 22, 23, 24, 26 and 27 is broader (Admitted on g. 19, ln. 5, is that claim 21 is broader than claim 1 and only differs in the "allowing more than six cards be dealt to the players. The scope of claim 23 is recited in claim 1, ln. 11 that "dealt cards not to exceed six") than that of claims 1-5 and 10.

As such claims 1-5, 10, 21-24, 26 and 27 shall stand or fall with the patentability of claim 1.

Claims 6 and 8 stand or fall together.

Claims 7, 9, 11 and 25 stand separately.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,988,643	Awada	11-1999
5,921,550	Awada	7-1999

The following is the prior art not relied on but cited as to develop only a portion of what is known in the art of gaming, poker and blackjack at the time of the invention. These references show the general skill of one practicing in the art of gaming and the motivation that would provide such persons. See In re Berg, 65 USPQ2d 2003 (Fed. Cir. 2003).

Scarne's Encyclopedia of Card Games, by John Scarne (New York, Harper and Row), pgs 40 and 41, 1983.

Basic Blackjack, by Stanford Wong (La Jolla, CA, Pi Yee Press) pgs. 83-89, 1992.

Scarne's Complete Guide to Gambling, by John Scarne (New York, Simon and Schuster) pgs 577-587, 1961.

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4,531,187	Uhland	7-1985
5,908,353	Andrews	6-1999
5,901,958	Andrews	5-1999
5,685,774	Webb	11-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awada '643 in view of Awada '550.

With respect to claims 1, 21 and 23-27, '643 clearly shows the claimed invention except for the resolution of the final game, the poker hand. In '643 both the dealer's and player's hand are completed and compared to resolve it. '550 teaches in a "three segment game play" (pg. 5, ln. 13 of remarks) to compare the players cards to a final pay table. This method eliminates the involvement of dealing cards to the dealer (verse games where players cards are compared to the dealers to resolve the wager), hence, speeding up the game. It is known to be desirable to speed the play of a game (i.e. more hands per given time) in order to increase profitability to the house (See Cabot, col. 1, lns. 38-50 for example). To have used the '550 method of resolving the final wager in '643 would have been obvious in order to speed up the play of the game. With respect to the dealer not dealing more than six additional cards, '643 shows that no more than seven additional cards and '550 teaches no more than five additional cards. Therefore the art of record fairly teaches a range of cards to be dealt from five to seven that encompass appellants claimed six cards. Claims 2-5, 8, 10, 11 and 22 are well known to wagering and clearly taught by the applied art.

With respect to claim 6, a player winning his hand upon receiving a number of cards without busting is known to the game of Blackjack. The splitting of only aces is admittedly old by appellant on pg. 3, ln. 22 of his specification.

Claim 7 is admitted prior art on pg. 3, ln. 7 of appellant's specification and the design of a paytable as called for in claim 9 is a matter of choice.

(11) Response to Argument

The Boards attention is directed to appellant's claims of potential infringement set forth in Petition filed 1/14/02, paper No. 6. In this petition, appellant refer to an article in GamingToday that shows, Yehia Awada (inventor

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of applied art in this case), describing each and every limitation of the instant claimed invention presented here before the Board. However, the October 16, 2001 date of this reference does not render it prior art. While appellant makes the statement in his specification on pg. 3, ln. 21 the "3 Way Action" is prior art and the article from Gaming Today at the bottom of the third column describes "3 Way Action" as exactly reading on the claims of the instant application, the combination of applicant's own admissions and this article were not considered to render a sound grounds for rejection since the date of the reference was not prior art and the article could in fact only represent improvements in the game that were made after the critical date. The Board should also be aware that, in addition to having been employed by D.P. Stud, it is believed that Yehia Awada was also a former employee of Shuffle Master, the Assignee of the instant application. While this has little to do with the Board's decision on the merits in this case, it is brought to their attention to bring to light the importance of the disposition of this application.

a) The Rejection of Awada '643 in view of his later variation to the game in Awada '550 render appellant's claims obvious.

The '643 reference set forth a game that is exactly the same as that which is being claimed by appellant with the difference being in how the wager of the third "poker" hand is resolved. In '643, after the second black jack wager, a player is dealt additional cards "until each holds seven cards" (abstract, ln. 19) and those cards are compared to cards dealt to the dealer. '643 is silent with respect to using a payable to resolve the outcome of this third wager. In '550 it can be seen that the prior art clearly teaches that a wager can be resolved by comparing it with a payable. In this '550 game play between the dealer and the player is eliminated and a player compares his cards in each of the three phases of the game to a predetermined fixed standard. Evenso, '550 recognizes that wagers can be resolved by comparing cards against "other players" (col. 1, ln. 62) and "against a dealer" (ln. 65). However, he prefers the wagers in his this game be resolved against a "predetermined rank" (col. 2, ln. 12) as well as a predetermined "payout schedule" (ln. 27). These two references combined teaches that wagers can be resolved either by comparing a players cards to a dealers or by comparing his cards to a predetermined standard such as a payable.

Appellant presents the argument, "that play of a casino table card game switches from a player-versus-dealer game to a player-versus-paytable game at a critical junction in the play of a sequence game" (pg. 12, ln. 17, Brief). However, the Board should not get side tracked by this afterthought argument. The issue at hand, as called for by claim 1, ln. 17, is whether or not the issue of "resolving the third wager by comparing each player's hand to a pay table" is obvious. Therefore, the Board must decide whether the issue of resolving a wager in a game by

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comparing a players cards to a payable is fairly taught by the applied art and not whether "switching" is taught. This never presented before in the prosecution argument of "switching" is found nowhere in appellant's specification. In fact, it silent with respect to any discussion of why "switching from a player-versus-dealer game to a player-versus-paytable" is critical. His specification from pg. 4 to the top of pg. 7 only discuss the advantages of not having to deal, handle and consider the additional cards so "that game play rate is increased" (pg. 7, ln. 4). On pg. 13, ln. 6 of his specification, appellant states the he "has discovered that the primary reason why the prior art game described in Awada U.S. Patent 5,988,643 plays too slow, is because the poker hand takes too much time to resolve". Hence from the specification, it would appear that the problem at hand facing the inventor was one of finding a quicker way of resolving wagers. Clearly one would consider resolving a wager against a payable as taught by '550. In fact such a means of resolving wagers is known in the prior art for speeding up the play of a wagering game. Note Andrews 5,909,353 and 5,901,958 who respectively teach at (col. 4, ln. 16) and (col. 3, ln31+) that ;

It is a further object of the invention to provide a player-versus-paytable five-card draw poker video game and a player-versus-paytable stud poker video game for an individual gaming machine player involving the 20 cards forming the four suits of royal cards of a standard 52 card deck and which involves an appropriate mix of the elements of player skill and luck with a speed-up of game play time and the excitement of obtaining a royal flush or reversible royal flush as a high payoff hand.

and

It is a further object of the invention to provide a player-versus-paytable five-card stud poker game for up to seven players involving the 20 cards forming the four suits of royal cards of a standard 52 card deck and which involves an appropriate mix of the elements of player skill, psychology and luck with a speed-up of game play time and the excitement of obtaining a royal flush as a high payoff hand.

To say that the "applicant surprisingly discovered" (pg. 13, ln. 12 of the specification) is without any basis. Such results would be expected when one considers what is taught on resolving wagers by the applied art as a whole. Lastly, with respect to "switching" back and forth to how one resolves wagers, '550 clearly teaches that wagers can be resolved using a payable. In addition to his teaching, it would be realized that this game would be played at a fast rate of speed since no cards have to be handle and evaluated for the dealers play.. Note that in considering a the teachings of a reference, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) and that it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962). In considering such, to have resolved wagers using a payable

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would have been obvious to eliminate the dealers cards, eliminate the need to evaluate and handle these cards resulting in a faster paced game.

While Appellant make the remark that his "switching" from player-versus-dealer game to a player-versus-paytable occurs "at a critical junction in the play of a sequence game" (pg. 12, ln. 19), he elaborates no further on any problem that is solved or that is unexpected. As set forth above, player versus payable method of resolving wagers is a known and often practiced method of resolving wagers since it is quicker by manipulating and evaluating fewer cards. Lastly, even if "switching" were to be entertained as containing some advantage "at a critical junction", it is well settled that the mere allegation that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

At the bottom of pg. 12, appellant states that, "the critical step of switching from player-versus-dealer game to a player-versus-paytable" game was not known in the art. However, this statement does not accurately represent to the Board what is known in the art. In addition to the references to Andrews, the Board should consider Webb 5,685,774. In the abstract, he states that "card-type games provide at least one player with the option of wagering against either a predetermined payout schedule, a dealer's hand, or both." As shown by the prior art, the "switching" from player-versus-dealer game to a player-versus-paytable (i.e. the method chosen to resolve a wager in a game) is at best a matter of choice.

On pg. 13 of his Brief, appellant argues '550 alone. These arguments the '550 reference individually should be considered by the Board as unpersuasive since it is known that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). One must consider the art as a whole and the combination of what is fairly taught by both the '643 and '550 references in view of what is known to one of ordinary skill in the art of wagering games and how wagers are resolved. Both the '643 and '550 references disclose a sequence of three games played back to back in a round of wagering and they were presented by the same inventor, Yehia Awada, and represent variations on the same inventive concept. Hence, in considering such, the examiner's position pertaining to obviousness is clear that any difference in the claimed invention and the prior art would "flow naturally" (*Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985)) and should be affirmed.

The number of cards dealt in a variation of a poker game is an obvious matter of choice. At the top of pg. 14, appellant questions the Board as to whether or not dealing six cards to a player would have been obvious. '643

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shows that the final hand in the poker wager should contain 7 cards and '550 teaches that the final hand in the poker wager should contain 5 cards. Hence the prior art fairly teaches a range from 5 to seven cards for the final poker hand, which encompass applicant's claimed six card hand. In addition, one must consider what is known in the art of poker games in general and that one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962)). Appellant would like to Board to believe that his claimed invention by changing the number of cards dealt in the third poker wager represents a patentable advance when in fact the number of cards used in a poker game is a matter of choice. Scame's Encyclopedia of Card Games demonstrates to the Board the ordinary level of skill in the art and that the number of cards can be from 2 to 9. More on point Scarn'e discusses variations of poker "Six-Card Stud" and "six-card High-Low Stud". Clearly one of ordinary skill in the art would realize that the number of cards dealt in a poker game variation is an obvious matter of choice. The Board should find that modifying '643 to have a final poker hand from 7 to six cards would have been an obvious matter of choice to reduce the number of cards and change the players probability of obtaining a winning combination of cards.

This number of cards is not a "highly significant issue" and the appellant has not shown anything critical to the claimed invention by solving any particular problem or producing any unexpected results. The "house percentage", or potential hold for the house, as appellant like to refer to it is one of mathematics that are well within the skill level of one practicing in the art of wagering games. Scarn'e Complete Guide to Gambling is provided with this answer so that the Board can easily ascertain to level of ordinary skill and not be hoodwinked by such an argument. Hence considering how the number of cards affects the play of poker is well known to one skilled in the art of Poker, the ground for rejection should be affirmed.

It would have been clearly obvious to have provided player verse payable in a the game of '643. The art as a whole must be considered by the board as well as what it would have "suggested" to one of ordinary skill. '643 shows that same game as being claimed by that of the appellant with the exception of the manner in which the third poker bet is resolved. '550 also shows the same game as that being claimed by the appellant with the exception that the wagers are resolved against a fixed standard and play against a dealer has been eliminated. '550 clearly teaches resolving wagers by eliminating the play against the dealer in games that are of the same nature and also by the same inventor. Hence, eliminating play against the dealer in '643 is clearly taught by '550. It is ludicrous to consider that "switching" between the two is some patentable advance. If this were true then separate patents should also issue for only changing the first wager of '643 to a player verse fixed value of 9 as taught by '550. Likewise a separate patent should issue for only changing the second wager of '643 to a player verse payable of a pair of 9's or

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better. As set forth above, the number of cards in the third wager is a matter of choice. How the number of cards dealt to a player affects his chances of obtaining a winning combination of cards is well known to one skilled in the art as demonstrated to the Board by the provided references to Scarne. The changes made to appellant's claimed invention that make it different than the '643 game are not significant and does not solve any particular problem or produce any unexpected results. Hence, the Board should clearly affirm the grounds for rejection.

Speeding up the play of a wagering game and reducing misdealt hands while maintaining house percentage is presumed within the skill of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Basically, in designing a game, the Casino is concerned with "how fast they can take a player's money". This is a consideration by how often, how much and how many wagers a player places during a game. For example, low wagers attract players but reduce house take, whereas high wagers deter play. In card games the number of cards that needs to be dealt is always a consideration since the manipulation and evaluation of cards obviously becomes more intensive as the number increases. Further, as more cards are used throughout the play of the game, the dealer must stop more frequently to shuffle. Casinos have the job of designing games with a certain balance that is known to one of ordinary skill in designing games. In this balance is the type of wagers, number of wagers offered (such as side bets), amount of wagers, the deal, the payout odds and etc., all of which are directed to maximize player attraction and house profit. Appellant's game on the other hand has done nothing more than provide a variation on a game already being practiced in the art that is protected by the Patent in '643. His variations include resolving wagers by referring to a fixed table rather than between a dealer and changing the number of cards. Both of these variations are well known alternatives available to game designers practicing in the art that don't solve any particular problem in a way that was not obvious nor do they produce any unexpected results.

As set forth above, the resolving of wagers between a fixed payable is fairly taught by the prior art. In evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Clearly considering resolving wagers as taught by '550 against a payable would involve the "cessation of dealing to the dealer after the competition in at least two games". Since the wager is no longer being resolved against the dealer, any cards dealt to him would just be wasted. Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962).

b) Claim 6 calls for limitations that are old and well known to the game of blackjack. Appellant admits that these limitations in this claim are known to the game of Blackjack. For the information of the Board, chapter 9 of Basic

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Blackjack is provided with this answer that demonstrates a win for the player in the event of being dealt six or seven cards. Appellant's claim 6 allows up to a maximum number of cards required to resolve the final third poker wager (which is by choice 6 cards). '643 also allows up to a maximum number of cards required to resolve the final third poker wager (which is by 7 cards). As set forth above, changing the number of cards in a poker game is an obvious matter of choice. To have applied the known blackjack rule to the game of blackjack being played in '643 would have been obvious in order to change a player's strategy.

With respect to the splitting of aces in claim 6, such is admittedly old by appellant on pg. 3, ln. 22 of his specification.

c) Player to retain one-half the original wager in the first game as recited in claim 7 is admitted prior art on pg. 3, ln. 7 of appellant's specification.

No further comment is deemed necessary with respect to this issue.

d) Claims relating to a specific payable are an obvious matter of choice.

As stated by the appellant on pg. 18, ln. 8 of Brief, "each payable.

) The forbidding of touching cards in the play of a casino game is so notorious that the Board should be astounded that appellant even brings this issue before them.

See Patent no. 4,531,187, col. 3, lns. 9-25 for example. No further comment is deemed necessary with respect to this issue.

f) Claim 21 stands or falls with Claimw 1-5 and 10 as set forth above in the Grouping of the Claims and paragraph a) above.

Admitted on g. 19, ln. 5, is that claim 21 is broader than claim 1 and only differs in the "allowing more than six cards be dealt to the players. Appellant's subsequent arguments under this paragraph rehash arguments previously addressed above with respect to claim 1. As such claim 21, 22, 24 and 26 stand or fall with the Board's decision with respect to claim 1.

g) Claims 23 and 27 stand or fall with claims 1-5 and 10.

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The scope of claim 23 is recited in claim 1, ln. 11 that the "dealt cards not to exceed six". This issue was discussed above with respect to claim 1 and no further comment is deemed necessary..

h) Claim 25 allows a player to choose from a total number of cards the cards that make up his final hand. In poker, it is old to allow a player to "discard" to make what he considers to be his strongest hand.

Allowing such in a "poker" variation game would have been obvious since it give a player some interaction and control over the cards that comprise the final hand. Further see Cabot, 5,322,295, col. 1, ln. 36, for a direct teaching in the art. While appellant wishes the Board to be so gullible as to consider him the inventor of discarding in a game of poker, examiner is confident that is not the case. As such, this ground for rejection should be sustained.

With respect to the Declaration of Roger Snow, examiner is quite clear that there exist no nexus between applicant's claimed invention and the remarks made therein.

THREE WAY ACTION is offered by an independent inventor, Yehia Awada. Shuffle Master Gaming, the assignee of record, is huge in comparison. Any decline of 3-Way and the number of tables being fewer than the appellant's Triple Shot game is largely do to better financial means to promote, market and license at a more competitive rate. Being larger, their presence and network within the gaming industry also is stronger giving them a greater ability to place games within a casino. Further, the rate at which a game is played and the hold is only one factor considered by a casino. Further is player interest, player loyalty, type of player attracted and etc. In fact, many players do not like more "passive" game such as comparing to a payable. Many players prefer dealer to player interaction. In short, appellant has not shown where any success of his invention is related to the claimed invention and not to any cheaper offering to industry, incentives offered to casinos to place the game, hard promotion and the like. As such the Board such find that secondary consideration of the Declaration of Roger Snow is weak in rendering the grounds for rejection non-obvious.

The examiner requests the opportunity to present arguments at the oral hearing.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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PRIMARY EXAMINER

wp
March 31, 2004

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